

**REMARKS/ARGUMENTS**

Applicant submits this response to the final Office Action dated April 16, 2009. Claims 1 – 10 are pending in this application.

**I. Oath and Declaration**

In the Office Action dated April 16, 2009, the Examiner rejected claims 1 – 10 under 35 U.S.C. § 251 because of a defective oath and declaration. Applicant has included herewith a revised reissue application declaration by the inventor, a revised reissue application declaration by the assignee, and a supplemental declaration for reissue patent application to correct “errors” statement. Applicant avers that these documents comply with 37 C.F.R. § 1.175.

**II. Double Patenting**

The Examiner has rejected Claims 2 – 10 on the ground of nonstatutory obviousness type double patenting. Applicant has included herewith a terminal disclaimer with respect to U.S. patent no. 7,047,697.<sup>1</sup> Applicant therefore requests that the Examiner withdraw this ground for rejecting Claims 2 – 10.

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<sup>1</sup> The Examiner also cites patent no. 7,188,736 in the last sentence of the first paragraph on page 5 of the current Office Action. Applicant assumes that this was a typographical error since patent no. 7,188,736 is directed to quite different subject matter than Applicant’s application.

### **III. Recapture**

The Examiner has also rejected Claim 10 under 35 U.S.C. § 251 for improperly recapturing subject matter surrendered during the initial prosecution. Specifically, on page 5 of the Office Action, Examiner states that “[b]y rewriting original claim 10 in independent form Applicant at the time has surrendered any version of claim 10 that does not specifically include all of the language of the limitation in question (within paragraph d namely, ‘a series of longitudinally extending lands and crests’).” Applicant avers that this statement is contrary to the express holdings of the Court of Appeals for the Federal Circuit and the Board of Patent Appeals and Interferences. *See Ex parte Yamaguchi*, 61 USPQ2d 1043 (BPAI 2001) (precedential); *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003) (precedential); *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997).

A. Rewriting Dependent Claim 10 into Independent Form: No Surrender of Subject Matter

As a threshold matter, Applicant still maintains that the mere rewriting of Claim 10 into independent form, without more, does not entail surrender of any subject matter.<sup>2,3</sup> During the prosecution of the parent patent application, Applicant never made any arguments whatsoever as to how any of his amendments to the claims helped distinguish his claims over the prior art. This is especially true with respect to the non-substantive “amendment” to Claim 10 (which was

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<sup>2</sup> See *Ex parte Yamaguchi*, 61 USPQ2d 1043 (BPAI 2001) (precedential), “[T]he prosecution history of the original application contains none of the evidence relevant to surrender discussed in *Hester Industries* . . . in that it contains neither any [substantive] amendments to the claims, nor any arguments made by appellants to overcome prior art or for any other purpose.” The Board noted, in footnote 3, that several minor, non-substantive amendments were made to the claims that were “not relevant” to the recapture analysis.

See also *Dethmers Mfg. Co., Inc. v. Automatic Equipment Mfg. Co.*, 299 F.Supp.2d 903 (N.D. Iowa 2004) (no surrender of subject matter because applicant’s amendments were not made to overcome a prior art rejection; Supreme Court’s *Festo* decision relates only to prosecution history estoppel, not to the recapture rule).

See also MPEP § 1412.02 (I)(B)(1)(A), “If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art.” (emphasis added).

During the prosecution of the parent application, Applicant’s non-substantive “amendment” of Claim 10 was not made to define over the prior art. Indeed, Applicant did not present any “new” or “amended” limitations when rewriting Claim 10 into independent form. Thus, there was no surrender related to the rewriting of Claim 10 into independent form.

<sup>3</sup> Subject matter can be surrendered by the Applicant’s arguments, *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998), or by Applicant’s substantive amendments to claims (including “amendments” by cancellation of a rejected claim and substantive additions to another claim), *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997); *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366 (Fed. Cir. 2001); *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005). In the present case, however, Applicant made no arguments as to why Claim 10 was patentable over the

merely to rewrite a claim with allowable subject matter into independent form). Indeed, it was unnecessary for Applicant to argue which particular limitations of dependent Claim 10 rendered it patentable over the prior art because the Examiner indicated (in the first Office Action) that Claim 10 contained allowable subject matter.

Nor did the Examiner ever cite which particular limitation(s)<sup>4</sup> of dependent Claim 10 rendered it patentable over the prior art. Even assuming, *arguendo*, that Applicant's cancellation of original Claim 1 and rewriting of dependent Claim 10 into independent form entailed the surrender of subject matter found in dependent Claim 10, it is impossible to determine from the record exactly which features of dependent Claim 10 rendered it patentable over the prior art.

Indeed, in the first (and only) Office Action during prosecution of the parent application, the Examiner only cited the following elements from the prior art (*Snear* and *Tal* patents) as anticipating original Claim 1: "decking system formed of plastic planks [] each having connecting means [] projecting laterally beyond one side with a complimentary connecting means [] projecting laterally beyond a second side. Reinforcing ribs [] interconnect the top and bottom walls." See *Office Action dated Dec. 18, 2000, page 3*. None of these elements from the prior art concern a "surface tread", whether "longitudinally extending" or not. (Nor do these

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prior art nor did Applicant make any substantive amendments to secure allowance of Claim 10 over the prior art.

<sup>4</sup> In the present reissue application, the Examiner seemingly treats original dependent Claim 10 (incorporated as paragraph (d) of issued Claim 10) as containing only a single limitation. Applicant disagrees and contends that paragraph (d) of issued Claim 10 contains a plurality of limitations, including at least: 1) a surface tread 2) formed on the exterior of said top portion 3) comprising a series of 4) longitudinally extending 5) lands and 6) crests 7) including parallel 8) major and minor lands 9) said major lands overlying at least said first side wall and 10) separated by major crests, 11) said major crest[s] having formed thereon 12) said minor crests and 13) minor lands.

elements concern any of the other limitations discussed in footnote 4, *supra*.) Thus, neither the Examiner nor the Applicant implicitly or explicitly discussed which limitation(s) of dependent Claim 10 rendered it patentable over the prior art.<sup>5</sup> Indeed, it seems that any one of the 13 identified limitations cited in footnote 4, *supra*, would be sufficient to yield patentability over the prior art. Certainly the recapture doctrine does not require that each and every one of these 13 limitations be present in a reissued Claim 10 in the absence of specific reliance on the entire combination of all 13 limitations.<sup>6</sup>

For all of the above reasons, Applicant did not surrender any subject matter when he rewrote, without comment or argument, dependent Claim 10 into independent form. Applicant

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<sup>5</sup> Indeed, the prior art *Snear* and *Tal* patents do not teach many details about a surface tread. The *Tal* patent seemingly teaches nothing about a tread and the *Snear* patent merely teaches that that “[u]pper deck surface 601 may be textured, etched, or coated with materials to provide traction and to facilitate runoff of water or other fluids from the upper deck surface 601.” Neither patent discusses “lands”, “crests”, “major and minor lands”, “major crests”, “minor crests”, “parallel”, “overlying at least said first side wall”, “separated by major crests”, “having formed thereon”, or “longitudinally extending”.

Thus, unlike the situation in *Hester* or *North American Container*, Applicant did not present arguments or amendments that distinguished particular feature(s) of his invention over the prior art. (In *Hester*, the Applicant “relied heavily” and argued “repeatedly” that the “solely with steam” and “two sources of steam” features of his invention distinguished it over the prior art. In *North American Container*, the Applicant amended his claim to add the limitation that his inner walls were “generally convex” in order to distinguish the prior art patent, which he stated during prosecution were “slightly concave.”) By contrast, here Applicant never presented arguments or made amendments that (implicitly or explicitly) distinguished particular features of his Claim 10 over particular features in the prior art.

See also MPEP § 1412.02 I(B)(2)(A), “A general ‘boiler plate’ sentence in the original application will not, by itself, be sufficient to establish surrender and recapture. [. . .] An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture. [. . .] In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, applicant has not surrendered anything.”

<sup>6</sup> See *In re Richman*, 409 F.2d 269, 275 (CCPA 1969): “Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.”

did not make substantive amendments to Claim 10 that implicitly or explicitly distinguished certain features of Claim 10 over the prior art. Nor did Applicant make comments or arguments (or even acquiesce in comments made by the Examiner) that would suggest that he surrendered subject matter by rewriting Claim 10 into independent form. Because Applicant did not surrender any subject matter in rewriting Claim 10 into independent form, he is free to broaden Claim 10 without running afoul of the recapture doctrine.<sup>7</sup>

**B. Examiner's Application of a *Per Se* Rule; *Ex Parte Eggert***

The Examiner has seemingly applied a per se rule that Applicant may not amend Claim 10 in any way that does not include all the language of paragraph (d) of the issued claim. As stated in *Ex parte Eggert*,<sup>8</sup> “[t]he examiner contends that the recapture rule prohibits a patentee from obtaining in reissue any claim which does not include each and every limitation added to a claim . . . during the prosecution of the original patent application . . . . This approach, while certainly relatively simple in its application, has been expressly rejected by the Court of Customs and Patent Appeals (CCPA) and the Court of Appeals for the Federal Circuit (Federal Circuit).” 67 USPQ2d at 1723 (emphases added). The Board further stated that “[t]o adopt such a per se rule would be contrary to the language of 35 U.S.C. § 251 which permits broadened claims in a

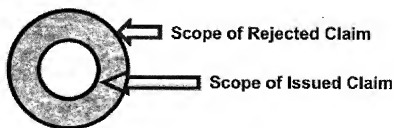
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<sup>7</sup> Applicant concedes that he could not broaden Claim 10 to the point that it was as broad as or broader than original Claim 1. Applicant has not done so, however. He has merely removed one of the 13 limitations that differentiated dependent Claim 10 from original Claim 1.

<sup>8</sup> Aspects of the *Eggert* decision were subsequently called into question by a divided Board of Patent Appeals and Interferences in an informative opinion, *Ex parte Kraus*, no. 2005-0841 (BPAI 2005). However, *Ex parte Kraus* is not a binding precedential decision of the Board. Further, the *Kraus* decision reiterated *Eggert's* admonition that Examiners should not use per se rules in applying the recapture doctrine.

reissue patent,” *Id.* at 1718, and reminded “the USPTO [that it] has been admonished for trying to extract per se rules from generalized commentary found in cases.” *Id.* at 1727.

To illustrate the proper scope of the recapture rule, the Board provided a visual depiction of the surrendered subject matter in its *Eggert* opinion. See *Id.* at 1717 (Drawing 1), reproduced below:



**Drawing 1**

In explaining the recapture rule in light of Drawing 1, the Board stated:

In our view, the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule.

*Id.* (emphasis added).

Applying this logic to the present case, Applicant avers that the “Scope of Rejected Claim” (outer circle) was the language of original Claim 1 in the parent patent application. Applicant avers that the “Scope of Issued Claim” (inner circle) is the language of Claim 10, as issued. As amended on October 24, 2007, Applicant’s current version of Claim 10 in the reissue

application clearly falls within the shaded area of Drawing 1 somewhere between original Claim 1 and issued Claim 10. That is, amended Claim 10 is broader than issued Claim 10, yet narrower than rejected (and subsequently cancelled) original Claim 1.<sup>9</sup>

Thus, as stated above in the quotation from *Egbert*, Applicant's amended Claim 10 is not barred by the recapture rule because the Examiner was never presented with a claim that fell within the scope of amended Claim 10 during prosecution of the parent application. During that initial prosecution, Examiner was only presented with 1) a claim having no tread whatsoever (original Claim 1), and 2) a claim having tread with longitudinally extending lands and crests, among other features (issued Claim 10). Examiner was never presented with – and Applicant never surrendered subject matter related to – a claim having tread with lands and crests oriented in a non-longitudinal manner.<sup>10</sup>

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<sup>9</sup> It is readily apparent that amended Claim 10 is broader than original Claim 1 because original Claim 1 did not recite a “surface tread” of any kind whatsoever.

<sup>10</sup> In further explaining the recapture rule, the Board stated that “[i]n the present case appellants believe that in . . . amending claim 1 . . . in an attempt to define patentable subject matter, they, in essence, overshot the mark in narrowing the claim by using the language added to claim 1 . . . , i.e., that they claimed less than they had a right to claim, and they now wish to ‘retreat’ back from the inner circle shown in Drawing 1 into the shaded area between the circles in a further attempt to define alternative patentable subject matter.” *Egbert*, 67 USPQ2d at 1717 (emphasis added). Similarly, Applicant “overshot the mark” by requiring longitudinally extending lands and crests in his tread and Applicant now wishes to “retreat” back to claim tread where the lands and crests are not necessarily longitudinal in orientation.



C. In re Clement

The Examiner's perfunctory rejection of Claim 10 is also contrary to the detailed three-step recapture analysis outlined by the Federal Circuit in the *Clement* decision.<sup>11</sup> *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997).

First Step

The first step of the *Clement* recapture test "is to determine whether and in what 'aspect' the [amended] reissue claims are broader than the patent claims." *Id.* at 1468. Applying this first step to Applicant's Claim 10, the "aspect" in which amended Claim 10 is broader than the reissue claims is that amended Claim 10 includes lands and crests in a non-longitudinal orientation.<sup>12</sup>

Second Step

The second step of the *Clement* recapture test is "to determine whether the broader aspects of the reissue claims relate to surrendered subject matter." *Id.* at 1468-69. As a first sub-step, the Examiner must "determine whether an applicant surrendered particular subject matter . . ." *Id.* at 1469. The second sub-step is determining "whether the surrendered subject matter[, if any,] has crept into the reissue claim." *Id.*

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<sup>11</sup> This three-step test was subsequent applied by the Federal Circuit in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998); *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366 (Fed. Cir. 2001); and *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005).

<sup>12</sup> Applicant's amended Claim 10 is also broader than the reissue claims in that amended Claim 10 includes apertures proximate the upwardly extending longitudinal wall.

First sub-step (of step 2)

To perform the first sub-step, the Examiner may “look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” *Id.* (citations omitted). As discussed in detail in Part A, *supra*, Applicant made no arguments to distinguish his claims over the prior art. Nor was Applicant’s amendment to Claim 10 made “in an effort to overcome a prior art rejection.” Thus, Applicant did not surrender subject matter related to the orientation of the tread. Nor did the Applicant surrender subject matter related to the placement of the apertures since neither Applicant nor Examiner cited the location of the apertures as necessary for imparting patentability over the prior art.

Applicant concedes that, by cancelling original Claim 1 when faced with a prior art rejection, he may have surrendered subject matter for any claims as broad as or broader than original Claim 1. *See Id.*: “Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggest that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable . . . .” (emphasis added). However, as discussed above in Part B, *supra*, Applicant certainly made no arguments or amendments suggesting that he surrendered all rights to Claim 10 that did not include each and every one of the 13 limitations found in paragraph (d) of issued Claim 10.

Second sub-step (of step 2)

To perform the second sub-step, the Examiner must “determine whether the surrendered subject matter[, if any,] has crept into the reissue claim.” *Id.* Because Applicant did not

surrender subject matter related to the orientation of the tread or the placement of the apertures, no surrendered subject matter has crept back into the reissue claim. If Applicant had removed all of the limitations of paragraph (d) of Claim 10, then the scope of the claim would be as broad as or broader than original Claim 1 and then the recapture doctrine may have been triggered. Because Applicant only removed one of the 13 limitations that distinguished Claim 10 from original Claim 1, however, no surrendered subject matter has crept back into the reissue claims. Therefore, the recapture rule has not been violated.

### Third Step

The third *Clement* step, to be applied in situations where a broadened aspect of a reissue claim does relate to surrendered subject matter, is to “determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.” *North American Container*, 415 F.3d at 1349. Because none of the broadening aspects of Claim 10 relate to surrendered subject matter, it is unnecessary to apply this step.


**IV. Conclusion**

In conclusion, Applicant submits that the application is in condition for allowance and earnestly requests same.

If any additional fees are due in connection with the filing of this paper or the accompanying papers, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to SGR Deposit Account No. 02-4300, Order No. 043850.016. If an additional extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The additional extension fee also should be charged to SGR Deposit Account No. 02-4300, Order No. 043850.016. Any overpayment can be credited to Deposit Account No. 02-4300, Order No. 043850.016.

Respectfully submitted,

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